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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,975	08/21/2001	Kazuhiro Fujimaki	003510-110	6820

7590 02/25/2004

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,975

Applicant(s)

FUJIMAKI ET AL.

Examiner

Barbara Gilliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. The amendment filed November 25, 2003 has been received and fully considered.
2. Claims 1-10 are present. Non-elected claims 11-20 are withdrawn from consideration.

Terminal Disclaimer

3. The terminal disclaimer filed on November 25, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application No. 10/080,654 (US 6,653,050) has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-8, 13-16 of copending Application No. 10/223,700 in view of Aoshima (US 6,566,035 B1).

In copending application 10/223,700, (US 2003/0146965 A1) Fujimaki et al. claim a negative image recording material on which an image is formable by exposure, comprising a specific polymer compound having at least one of the groups represented by the general formulae (1) to (3) in the side chain thereof (claims 1 and 8). The general formula (1) to (3) are identical to the general formulae (1) to (3) of the present application. The specific polymer is aqueous alkaline solution soluble (claim 1), contains at least 1.5 meq/g of the carbon-carbon double bond in the side chain thereof (claim 4). The principal chain structure of the polymer can be a poly(meth)acryl resin, a polystyrene resin, a polyurethane resin or an acetal-denatured polyvinyl resin (claim 7) and has a weight average molecular weight of 6,000 or more (claims 13-14). Fujimaki et al. do not claim the carboxyl acid group content of the specific polymer however the carboxyl acid group content of specific polymer of Fujimaki et al. is expected to overlap with the required range of the present application because three of the possible polymers comprising a group of general formulae (1) to (3) is specifically claimed by Fujimaki et al. Further the weight average molecular weight of the specific polymer in Fujimaki et al. fully encompasses the weight average molecular weight range required in the present application. Therefore absent any contrary evidence, one of ordinary skill in the art would expect the carboxyl acid group content of the polymers to overlap at the very least. The material comprises a radical-polymerizable compound (claim 2), which meets the present limitations for the same. The negative image recording material of

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Fujimaki et al. further comprises a light-heat converting agent (claim 1) which meets the limitations for the photothermal conversion agent (B). Fujimaki et al. do not specifically claim a cyanine dye as the photothermal conversion agent however, as evidenced by the teachings of Aoshima (US 6,566,035 B1), cyanine dyes are preferred infrared absorbing substances that allow one to adjust the absorbance of the recording materials (column 3, line 34 – column 4, line 49). The material comprises a compound that generates radicals by exposure using light of a wavelength absorbable by the light-heat converting agent (claim 1). Fujimaki et al. do not claim specific radical generating compounds however it would have been obvious to use conventional radical generating compounds such as the onium salts of Aoshima (US 6,566,035 B1; column 10, lines 45-65; column 15, lines 1-5) which have an absorption maximum not longer than 400 nm so that the recording material can be handled under white lamp.

This is a provisional obviousness-type double patenting rejection. Application No. 10/223,700 has been patented however the patent, US 6,702,437, has a issue date of March 9, 2004. Upon issue, this provisional double patent rejection becomes a double patenting rejection.

Response to Arguments

6. Applicant's arguments filed November 25, 2003 have been fully considered but they are not persuasive.

a. Applicants did not file a Terminal Disclaimer over copending Application No. 10/223,700 and do not concede the propriety of the double patenting rejection. According to Applicants, withdrawal of the sole rejection is believed to be proper since

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the sole remaining rejection is a double patenting rejection over an application with a later filing date, pursuant to the provisions of MPEP 804 I.B. The Examiner disagrees. Applicant is reminded that a rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). MPEP 804, II., B. The obviousness-type double patenting rejection over Application 10/223,700 is proper because the claimed subject matter is not patentably distinct from the subject matter claimed in the commonly owned Application and the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001). MPEP 804, II., B., 1. Additionally it does not appear a double patenting rejection was made in Application No. 10/223,700 (now US 6,702,437 - issue date March 9, 2004). No further arguments with respect to the propriety of the double patenting rejection were presented.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara Gilliam
Examiner
Art Unit 1752
February 20, 2004

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